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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHERWIN SHANG, TAHUA YANG, MICHAEL T. K. LING,
LEE WOO, JEAN-CLAUDE BONTE, MICHAEL BECKER,
MICHAEL MASTERSON, JAMES J. PETERSON,
and CRAIG SANDFORD

Appeal 2008-4272
Application 09/917,136
Technology Center 1700

Decided: September 25, 2008

Before BRADLEY R. GARRIS, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 16-19 and 145-161.¹ (Examiner's Answer entered Oct. 18, 2007, hereinafter "Ans."). We have jurisdiction pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

THE INVENTION

Appellants' claimed invention is directed to a monolayer film comprising a polymer blend composed solely of a cross-linked first component having a first melting point temperature determined by differential scanning calorimetry (DSC) and a second component, which is not cross-linked, having a second melting point temperature determined by DSC. (Spec. 6, l. 30 - 7, l. 8). The first component is an ethylene containing polymer present in an amount from about 55% to about 99% by weight of the film. (Spec. 13, l. 24 - 14, l. 14). The second component is a propylene containing polymer or a methyl pentene containing polymer present from about 45% to about 1% in an amount by weight of the film. (Spec. 14, ll. 15-30).

Claims 16, 19, and 145, reproduced below, are representative of the subject matter on appeal.

16. The film of claim 145, wherein the methyl-pentene-containing polymer is selected from the group consisting of: homopolymers of 4-methylpentene-1, and copolymers of 4-methylpentene-1.

¹ Claims 1-15, 20-144, and 162-194 have been canceled. (Appeal Brief filed Jun. 18, 2007, hereinafter "Br.," 4).

19. The film of claim 145, wherein the first component is present in an amount by weight of from about 65% to about 75%.

145. A monolayer film comprising:

a polymer blend composed solely of a first component and a second component, the first component being cross-linked and selected from the group consisting of an ethylene containing polymer, the first component present in an amount by weight of the film from about 55% to about 99%, the first component having a first melting point temperature determined by DSC;

the second component selected from the group consisting of propylene containing polymers and methyl pentene containing polymers, the second component being present in an amount by weight of the film from about 45% to about 1% the second component having a second melting point temperature determined by DSC, and the second component is not crosslinked.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Woo	6,743,523	Jun. 1, 2004 (Mar. 16, 2000)
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The Examiner rejected claims 16-19 and 145-161 under 35 U.S.C. § 102(e) as being anticipated by or in the alternative obvious over Woo. The Examiner determined that although Appellants claim priority to U.S. Patent 6,969,483, which has a filing date of March 16, 2000, (hereinafter “the Parent”), the effective filing date of the present claims is July 27, 2001, the filing date of the present application. (Ans. 4). The Examiner found that the Parent does not support the limitation that “the second component is not

cross-linked.” *Id.* The Examiner found that Woo anticipated or rendered the present claims obvious because Woo’s examples were identical to Appellants’ examples, and therefore Woo’s examples would be expected to reasonably share characteristics with Appellants’ claimed film. (Ans. 4 and 5).

Regarding claim 145, Appellants do not challenge the Examiner’s findings with respect to Woo’s disclosure, but contend that Woo is not prior art to the present application because both the Parent and Woo were filed on the same day. (Br. 9 and 10). Appellants argue that the examples relied upon by the Examiner for anticipation and obviousness purposes are the same examples disclosed both in the present application and the Parent, and thus, cannot be used as prior art against the present claims. (Br. 10). Appellants also contend that the present claims are fully supported by the Parent, which provides examples of second components that are not cross-linked. (Br. 11 and 12). Appellants further argue that claims 16 and 19 are not anticipated or rendered obvious in view of Woo. (Reply Brief filed Dec. 12, 2007, hereinafter “Rep.,” 4).

ISSUE

Based on Appellants’ and the Examiner’s contentions, we frame the issue as: Have Appellants shown that the Examiner erred in finding that Appellants are not entitled to the priority date of the Parent?

We answer this question in the negative.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The present application was filed on July 27, 2001. (USPTO Patent Application Locating and Monitoring (PALM) system).
2. The present application was filed as a continuation-in-part of the Parent. (Spec. 1, ll. 10-12).
3. Appellants have added a definition of “cross-link,” “readily cross-linkable polymer,” and “non-readily cross-linkable polymer,” definitions not present in the Parent. (Spec. 12, l. 27 –Spec. 13, l. 23).
4. The Parent was filed on March 16, 2000. (U.S. Patent No. 6,969,483, front page).
5. The Parent states:

The preferred method of irradiating the film is to expose it to an electron beam with beam energy from about 150 Kev-10 Mev, more preferably from 200-300 Kev and a dosage from about 20 kGys to about 200 kGys and more preferably from about 60-150 kGys. Alternatively, the film can be crosslinked using methods known to those skilled in the arts. Methods for crosslinking employed in the industry include exposure to ionizing radiation (gamma, beta, ultraviolet, etc.) and chemical (peroxides and condensing reactions). (Col. 9, ll. 41-50).

6. The Parent is silent as to the individual cross-linking characteristics of the first and second component.
7. The Parent claims a cross-linked polymer, comprising a blend of a first and second component, and provides no express disclosure that the second component is not cross-linked. (Col. 12, l. 14 – col. 13, l. 12).

8. The Table in the Parent contains at most eight examples (Examples 2-4 and 6-10) that would support the present claims. (Col. 11-12).
9. The Parent fails to disclose methyl pentene containing polymers that are not cross-linked in the examples or anywhere in the Parent disclosure.
10. Woo was filed on March 16, 2000. (U.S. Patent No. 6,743,523, front page).
11. Woo teaches polymethylpentene as the second component. (Col. 4, ll. 38-39).
12. Woo teaches an amount of first component from about 65% to about 80%. (Col. 5, ll. 23-26).

PRINCIPLES OF LAW

In order to be entitled to the benefit of a parent application, one requirement is that the invention presently claimed must have been disclosed in the parent application in the manner provided by 35 U.S.C. § 112, first paragraph. *See* 35 U.S.C. § 120; *In re Lukach*, 442 F.2d 967, 968-69 (CCPA 1971). 35 U.S.C. § 112, first paragraph states that “[t]he specification shall contain a written description of the invention....” 35 U.S.C. § 112.

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *See Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Nonetheless, the disclosure “must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Put another way, one skilled in the art,

reading the original disclosure, must “immediately discern the limitation at issue” in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). That inquiry is a factual one and must be assessed on a case-by-case basis. *See Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116.

Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1326-27 (Fed. Cir. 2000).

In *Purdue*, the limitation “a maximum plasma concentration (C_{\max}) which is more than twice the plasma level of said opioid at about 24 hours after administration of the dosage form [C_{24}]” was not adequately described in the parent application, where the parent application disclosed two examples that when calculated, possessed a C_{\max}/C_{24} ratio greater than two. *Purdue*, 230 F.3d at 1323, 1326. The court stated that “neither the text accompanying the examples, nor the data, nor anything else in the specification in any way emphasizes the C_{\max}/C_{24} ratio.” *Purdue*, 230 F.3d at 1326. The court also stated, “one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say ‘here is my invention.’ In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure.” *Purdue*, 230 F.3d at 1326-27, (citing *In re Ruschig*, 379 F.2d 990, 994-95 (CCPA 1967)). The court further stated that “there is nothing in the written description of [the examples] that would suggest to one skilled in the art that the C_{\max}/C_{24} ratio is an important defining quality of the formulation, nor does the disclosure even motivate one to calculate the ratio.” *Purdue*, 230 F.3d at 1327. The court went on to state that:

What the [] patentees have done is to pick a characteristic possessed by two of their formulations, a characteristic that is

not discussed even in passing in the disclosure, and then make it the basis of claims that cover not just those two formulations, but any formulation that has that characteristic. This is exactly the type of overreaching the written description requirement was designed to guard against. *Purdue*, 230 F.3d at 1327.

In *Lukach*, an example from a grandparent application was relied on to support the claims at issue. *Lukach*, 442 F.2d at 968-69. The court stated:

We are thus left with the single example inherently disclosing a copolymer having a [molecular weight] ratio of 2.6. This single example does not alone provide support for the recited range from 2.0 to 3.0, and nothing has been brought to our attention to show that any other language in the grandparent application, taken together with the knowledge of persons skilled in the art, points to the recited range. Accordingly, the grandparent application does not, either expressly or inherently, disclose the invention now claimed, and appellant is not entitled to the benefit of the grandparent filing date.

Lukach, 442 F.2d at 969. Thus, the court found that a single example cannot be the basis of written description support, where the claimed limitation is not otherwise supported by language in a parent application.

In *In re Smith*, 458 F.2d 1389 (CCPA 1972), cited by Appellants (Br. 11-12), the court declined to find support in a parent application for coating compounds with at least 8 carbon atoms, when the earlier application generally disclosed coating compounds, and specifically those with at least 12 carbon atoms. 458 F.2d at 1395-96. The court compared the facts in *Smith* to the facts in *In re Ahlbrecht*, 435 F.2d 908, 58 CCPA 848 (1971), where the parent disclosure of fluorinated esters having “m” number of CH₂ groups, wherein “m” was disclosed as an integer from 3 to 12, was not a legally sufficient description of subsequently claimed esters wherein “m”

was an integer from 2 to 12. *Smith*, 458 F.2d at 1395-96. The court stated, “it cannot be said that such a subgenus is necessarily always implicitly described by a genus encompassing it and a species upon which it reads.” *Smith*, 458 F.2d at 1395.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

ANALYSIS

Appellants have not separately grouped the claims on appeal. Therefore, we limit our discussion to claim 145 and address claims 16 and 19 only to the extent that Appellants have argued them separately pursuant to 37 C.F.R. § 41.37(c)(1)(vii) (2006).² In addition, regarding claim 145, since Appellants do not challenge the Examiner’s findings regarding Woo’s disclosure, we limit our discussion to the issue of priority.

² Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

After careful review of both Appellants' and the Examiner's arguments, we agree with the Examiner, that claim 145 is not entitled to the priority date of the Parent. The Parent fails to provide the "blaze marks" necessary to reasonably convey to one of ordinary skill in the art that Appellants were in possession of the claimed subject matter at the time of filing the parent application. *See Purdue, supra*. The text of the Parent is silent as to the individual cross-linking characteristics of the first and second component. (FF 6). The Parent claims a cross-linked polymer, comprising a blend of a first and second component, and provides no express disclosure that the second component is not cross-linked, which the Examiner found was introduced *ipsis verbis* in the present application. (FF 7; Ans. 7). Moreover, Appellants have added a definition of "cross-link," "readily cross-linkable polymer," and "non-readily cross-linkable polymer," which are not present in the Parent. (FF 3). Thus, although the Parent generally discusses cross-linking (FF 5), the Parent provides no express disclosure that the cross-linking characteristic of the second component is an important defining quality of the polymer blend. *See Purdue*, 230 F.3d at 1327

Appellants point to Table 2 of the present application, which corresponds to the Table in Col. 11-12 of the Parent, and contend that the Table provides numerous examples of a cross-linked ethylene component and a propylene component that is not cross-linked sufficient to provide support for second components that are not cross-linked. (App. Br. 10 and 11). The Table contains at most eight examples that would support the

present claims.³ (FF 8). This is more than the one or two examples that were insufficient to support the claims in *Lukach* and *Purdue*. However, we agree with the Examiner that these examples are not sufficient to provide support for the full scope of the claim, particularly where the Parent fails to disclose methyl pentene containing polymers that are not cross-linked. (FF 9; Ans. 6)

Appellants have chosen a characteristic that is possessed by propylene homopolymers and propylene-ethylene copolymers of the examples in the Parent, and have made it the basis of claims in the present application that cover not just those examples, but any propylene or methyl pentene containing polymer second component that is not cross-linked. Thus, Appellants have created a sub-genus of non-cross-linked second components out of the genus of second components disclosed in the Parent based on the species disclosed in the examples of the parent application. See *Purdue*, 230 F.3d at 1327. In view of the Parent's failure to expressly describe second components that are not cross-linked, we are of the opinion that the subgenus defined by Appellants is not implicitly or inherently described in the Parent. In addition, the Parent specifically discloses ethylenically unsaturated substituents, which as found by the Examiner, indicates that the second component would be cross-linkable. (Ans. 7).

Thus, Appellants may not rely on the parent application, filed on March 16, 2000, for priority. (FF 4). Because the present application was filed as a continuation-in-part of the Parent on July 27, 2001, Woo, filed on

³ We note that Exxon PP 3505GE1, which is also included in the Parent Table, is the only second component in Table 2 of the present application that is specifically identified as non-crosslinkable. (Spec. 14, ll. 24-30).

March 16, 2000, is available as prior art against the present claims under § 102(e). (FF 1, 2, and 10). Even though the Table in Woo relied on by the Examiner is also present in the present application and the Parent, it constitutes prior art to the present claims. The court in *Lukach* stated:

Appellants have raised a further point. They contend that “[t]here is an inconsistency constituting an inequity in rejecting the claims as fully met by the Hercules British patent under 35 U.S.C. 102, while at the same time holding that appellants cannot obtain the benefit of the filing date of the U. S. counterpart.” What they are saying, in terms of the statute, is that if “the invention was * * * described” in the British reference within the meaning of § 102(b), there must have been a “description of the invention” in the corresponding grandparent application within the meaning of the first paragraph of § 112. This argument appears to overlook the law that the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes (see, e.g., *In re Ruscetta*, 45 CCPA 968, 255 F.2d 687, 118 USPQ 101 (1958)), whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure. See, e.g., *In re Ahlbrecht*, *supra*.

Lukach, 442 F.2d at 969-70. Therefore, Appellants’ argument that the Table in Woo is not prior art against the present claims is not persuasive. Since we find that Woo is available as prior art and Appellant does not contest that Woo anticipates, we affirm both the anticipation and obviousness rejections. *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982)(“lack of novelty is the ultimate of obviousness”).

Appellants also argue in reply that Woo fails to teach or suggest 4-methylpentene-1 as recited in claim 16 and an amount of first component

from about 65% to about 75% as recited in claim 19. However, Appellants provide no specific arguments as to why this is the case, particularly when Woo teaches polymethylpentene and an amount of first component from about 65% to about 80%. (FF 11 and 12).

CONCLUSION

In light of the above discussion, Appellants failed to demonstrate that the Examiner erred in rejecting claims 16-19 and 145-161 under 35 U.S.C. § 102(e) as being anticipated by or in the alternative obvious over Woo.

ORDER

The Examiner's decision rejecting claims 16-19 and 145-161 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PL initial:
sld

Appeal 2008-4272
Application 09/917,136

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